

REMARKS

Initially, Applicant would like to thank the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, as well as receipt of a certified copy of the document upon which the claim for foreign priority is based under 35 U.S.C. § 119. Applicant would also like to thank the Examiner for acknowledging consideration of the document listed on the Form PTO-1449 submitted with the Information Disclosure Statement filed on July 7, 2004.

In the outstanding Office Action, the drawings were objected to for a perceived inconsistency between the features shown in Figure 2A and the description of Figure 2A in the specification. Claims 1-13 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claim 7 was rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 1-4 were rejected under 35 U.S.C. § 102(b) over HIGUCHI et al. (U.S. Patent Application Publication No. 2001/0022612). Claims 5-9 and 13 were rejected under 35 U.S.C. § 103(a) over HIGUCHI in view of WADA (U.S. Patent No. 7,053,926). Claims 10-12 were rejected under 35 U.S.C. § 103(a) over HIGUCHI in view of OKADA (U.S. Patent Application No. 10/703,633).

With respect to the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a), Applicant initially notes that HIGUCHI (U.S. Patent Application Publication No. 2001/0022612) is not listed on the Form PTO-892 that accompanied the outstanding Office Action. Accordingly, Applicant respectfully requests that the Examiner list HIGUCHI on a Form PTO-892, initial the citation to HIGUCHI on the Form PTO-892,

and provide a copy of the initialed Form PTO-892 with the next Office Action for the present application.

Upon entry of the present amendment, Applicant will have amended the specification to clarify that the Examiner's perceived interpretation of Figure 2A is erroneous. That is, Figure 2A does not disclose a group of effective lines each labeled n-1, as asserted in the Office Action. Rather, Figure 2A uses a conventional sequential numbering system to number a sequence of lines as 1, 2, 3... n-2, n-1, n. Thus, the label n-1 is a label for one of a sequence of lines 1 to n, and the overall sequence was originally designated as 1-n. By the present amendment, each incidence of designation "1-n" in the specification has been replaced with the designation "1 to n". Accordingly, reconsideration and withdrawal of the objection to the drawings is respectfully requested.

Applicant traverses the rejection of claims 1-13 under 35 U.S.C. §112, second paragraph, as indefinite. The Office Action asserts that it is unclear what is to be superimposed with the digital information. However, nothing about claim 1 should be considered indefinite, at least insofar as digitized information (representing at least information intrinsic to the electronic endoscope and control information for the processor) is superimposed on the digital video signal (generated by the signal processing circuit). Accordingly, reconsideration and withdrawal of the rejection of claims 1-12 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Incidentally, Applicant notes that the Office Action asserts that claim 13 is rejected under 35 U.S.C. §112, second paragraph "for being dependent upon rejected claim 1". However, claim 13 is independent, and not dependent upon rejected claim 1 and, accordingly the form of the rejection of claim 13 under 35 U.S.C. §112, second

paragraph is improper. Nevertheless, the above-noted remarks which are applicable to claim 1 are also applicable to claim 13 and, accordingly, reconsideration and withdrawal of the rejection of claim 13 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Applicant traverses the rejection of claim 7 under 35 U.S.C. §112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. In this regard, claim 7 depends from claims 6, 5 and 1. However, the Office Action does not specify which, if any, of claims 6, 5 and 1 appear to recite the same features as claim 7. In any case, the features of the “controller” recited in claim 7 are not present in any of claims 6, 5 or 1. Accordingly, reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. §112, fourth paragraph, is respectfully requested.

Applicant traverses the rejections of claims 1-13 under 35 U.S.C. §102 and 35 U.S.C. §103. In this regard, the claims of the present application have been amended to clarify that the digital video signal includes a region included in a blanking interval, and that the digitized information in claim 1 and the control information in claim 13 is superimposed in the region included in the blanking interval. These features of the invention to which the pending claims are directed are disclosed at, e.g., paragraph [0056] of the present application.

In contrast, neither HIGUCHI, OKADA or WADA discloses such features. Rather, HIGUCHI discloses only a basic configuration of an endoscope system, and not the above-noted characteristic features. Further, the publication of OKADA and the

patent to WADA also nowhere disclose any features of a blanking interval as recited in claims 1 and 13.

Applicant particularly notes the statement in the Office Action at page 4 that “superimposing is nothing more than additional processing”. This assertion is entirely inappropriate, as there is no teaching anywhere, in the cited references or anywhere else in the record, that would support such a generic interpretation of the term “superimposing”. Accordingly, if the interpretation of the term “superimposing” in the outstanding Office Action is maintained to be appropriate, Applicant requests specific citation to authority for such unsupported interpretation, or support for the interpretation of the term “superimposing” (which Applicant submits does not exist).

Accordingly, each of independent claims 1 and 13 are allowable over the documents applied in the Office Action, whether these documents are applied alone or in any proper combination. Claims 2-12 are allowable over these documents at least for depending, directly or indirectly, from an allowable independent claim, as well as for additional reasons related to their own recitations.

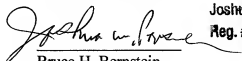
Incidentally, Applicant also notes that U.S. Patent Application No. 10/703,033 is not itself properly applied as “prior art” under any provision of 35 U.S.C. §102, and accordingly the form of the rejection of claims 10-12 is improper. However, insofar as U.S. Patent Application No. 10/703,033 was published as U.S. Patent Application Publication No. 2004-0104999, Applicant has reviewed U.S. Patent Application Publication No. 2004-0104999 to determine that OKADA does not disclose the above-noted features recited in claims 1-13.

Accordingly, reconsideration and withdrawal of each of the outstanding objection and rejections is respectfully requested, at least in view of the herein-contained amendments and the above remarks.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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A handwritten signature in dark ink, appearing to read "Joshua M. Povsner", is written over a horizontal line.

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